

Application: 10/035,516

Attorney Docket No. 112.P14195

REMARKS

The current patent application has been reviewed in light of the Final Office Action, dated April 6, 2006, (hereinafter "the office action"). The Assignee respectfully contends that this After Final Response should be admitted under 37 CFR 1.116(b)(3), as the Examiner's new citation of Seto, U.S. Patent No. 5,124,810 (hereinafter "Seto") shows good and sufficient reasons why the response was not presented earlier.

In the office action, claims 1-17, 25, and 26 were objected to because of various informalities, claims 1, 3, 11-14, 17-19, 30-33, and 35 were rejected under 35 U.S.C. §102(b) as being anticipated by Seto, claims 2 and 20-24 were rejected under 35 U.S.C. §103(a) as being unpatentable over Seto in view of Pasco et al., U.S. Patent No. 6,064,778 (hereinafter "Pasco"), claims 4-6, 15, 16, and 34 were rejected under 35 U.S.C. §103(a) over Pasco, claims 7-10 were rejected under 35 U.S.C. §103(a) over Pasco in view of what the Examiner contends is well known art, and claims 25-29 were rejected under 35 U.S.C. §103(a) as being unpatentable over Seto in view of Pasco in view of what the Examiner contends is well known art. Entry and consideration of this After Final Response is respectfully requested.

Claims 1-35 are currently pending. Claims 1, 3, 5, 7, 11-12, 14-15, 17-19, 25-26, 29, 31, and 35 have been amended without prejudice or disclaimer. Assignee has amended claims to more clearly delineate intended subject matter. The amendments to the claims are made without prejudice or disclaimer, and Assignee believes that none of these claim amendments constitute narrowing amendments. In fact, some of these claim amendments are intended to be broadening amendments. Accordingly, Assignee does not intend to surrender claimed subject matter by submission of the above amendments and no prosecution history estoppel should apply.

Objections to the Claims

Claims 1-17, 25, and 26 were objected to in the office action because of various informalities. Assignee respectfully submits that the above-mentioned claims have been amended

Application: 10/035,516

Attorney Docket No. 112.P14195

to address the Examiner's concerns. Assignee respectfully requests that the Examiner withdraw the objections to claims 1-17, 25, and 26.

Claim Rejections Under 35 U.S.C. §102(b)

Claims 1, 3, 11-14, 17-19, 30-33, and 35 are rejected under 35 U.S.C. §102(b) as being anticipated by Seto. However, Seto does not disclose

"capturing a first image of the document while the document is in said first position; feeding the document an appropriate length to a second position, wherein the appropriate length comprises a length that is less than a length of the document;

capturing a second image of the document while said document is in said second position"

(amended claim 1, emphasis added).

Claim 18 includes elements similar to those mentioned above in connection with claim 1. Therefore, claims 1 and 18, and the claims that depend from them, are not anticipated by Seto. Assignee respectfully requests that the Examiner withdraw the rejection to claims 1, 3, 11-14, 17-19, 30-33, and 35.

It is noted that claimed subject matter may be patentably distinguished from the cited patents for additional reasons; however, the foregoing is believed to be sufficient.

Claim Rejections Under 35 U.S.C. §103(a)

Claims 2 and 20-24 are rejected under 35 U.S.C. §103(a) as being unpatentable over Seto in view of Pasco, claims 4-6, 15, 16, and 34 are rejected under 35 U.S.C. §103(a) over Pasco, claims 7-10 are rejected under 35 U.S.C. §103(a) over Pasco in view of what the Examiner contends is well known art, and claims 25-29 are rejected under 35 U.S.C. §103(a) as being unpatentable over Seto in view of Pasco and in view of what the Examiner contends is well known art.

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the

Application: 10/035,516

Attorney Docket No. 112.P14196

knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Assignee's disclosure." MPEP § 2143. Assignee respectfully submits that the Examiner has not established a *prima facie* case of obviousness. The cited patents do not teach or suggest all the limitations of the aforementioned claims. Neither Pasco nor Seto disclose, either alone or in combination,

"capturing a first image of the document while the document is in said first position;
feeding the document an appropriate length to a second position, wherein the
appropriate length comprises a length that is less than a length of the
document;
capturing a second image of the document while said document is in said second
position"

as claimed in claim 1. Claim 18 includes similar limitations. Therefore, claims 1 and 18 and the claims that depend from them are patentably distinguished over the cited patents. Assignee respectfully requests that the Examiner withdraw his rejections to the aforementioned claims.

It is noted that claimed subject matter may be patentably distinguished from the cited patents for additional reasons; however, the foregoing is believed to be sufficient. Likewise, it is noted that the Assignee's failure to comment directly upon any of the positions asserted by the Examiner in the office action does not indicate agreement or acquiescence with those asserted positions.

Application: 10/035,516

Attorney Docket No. 112.P14195

CONCLUSION

In view of the foregoing, it is respectfully asserted that all of the claims pending in the present patent application are in condition for allowance. If the Examiner has any questions, he is invited to contact the undersigned at (503) 439-6500. Entry of this amendment and reconsideration of the present patent application in view of the same, and early allowance of all the claims is respectfully requested. Please charge any underpayments or credit any overpayments to deposit account no. 50-3703.

Respectfully submitted,

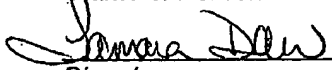
Date: June 23, 2006/Calvin E. Wells Reg. No. 43,256/Calvin E. Wells
Reg. No. 43,256

Berkeley Law and Technology Group, LLC
1700 NW 167th Place, Suite 240
Beaverton, OR 97006
503.439.6500
Customer No. 00043831

I hereby certify that this correspondence is being deposited via facsimile to the Commissioner for Patents on:

June 23, 2006
Date of Transmission

Tamara Daw
Name of Person Transmitting Correspondence


Signature

6/23/06
Date